UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/683,995	03/10/2002	Michael J. Curry	1049.002US1	2530

23441 7590 05/23/2003

LAW OFFICES OF MICHAEL DRYJA
704 228TH AVENUE NE
PMB 694
SAMMAMISH, WA 98074

EXAMINER
DINH, KHANH Q

ART UNIT	PAPER NUMBER
2155	7

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

Office Action Summary	Application No.	Applicant(s)	
	09/683,995	CURRY ET AL.	
	Examiner	Art Unit	
	Khanh Dinh	2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4, 5* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Claims 1-24 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4-10, 12, 13, 15-19, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Mattaway et al., US pat. No.6,131,121.

As to claim 1, Mattaway discloses a system comprising:

a network (24 fig.1) and a first client (12 fig.1) having a first email messaging program installed thereon on which a composing user composes a message and records media, the first email messaging program sending the message to a receiving user over the network (sending the email address of the callee through the connection server, see abstract, col.4 lines 14-65 and col.6 line 60 to col.7 line 53).

a second client (22 fig.1) having a second email messaging program installed thereon on which the receiving user receives the message over the network, the second email messaging program playing back the media upon the user viewing the message (see col.6 lines 1-59, col.8 line 8 to col.9 line 64 and col.16 lines 12-56).

As to claim 2, Mattaway discloses a streaming media server (24 fig.4), the first email messaging program uploading the media to the streaming media server upon the message being sent to the receiving user over the network, and the second email messaging program downloading the media from the streaming media server over the network upon the receiving user viewing the message (i.e., establishing real time point to point of multimedia signals over the internet, see col.9 line 5 to col.10 line 56 and col.16 line 12 to col.17 line 59).

As to claims 4, Mattaway discloses at least one of: the Internet, an intranet, an extranet, a local-area network (LAN), a wide-area network (WAN), a wired network, a wireless network, and a telephony network (see col.17 lines 14-60).

As to claim 5, Mattaway at least one of the first client and the second client comprises: a desktop computer, a laptop computer, a cellular phone, a wireless phone, a set-top box, and a personal digital assistant (PDA) device (see col.4 lines 14-65 and col.13 lines 2-64).

As to claims 6 and 7, Mattaway discloses text and at least one of: audio, video, streaming audio and streaming video (see col.14 lines 8-65).

As to claim 8, Mattaway discloses a system comprising:

a networking mechanism communicatively coupling the system to a network (24 fig.1).

an email messaging program having at least a composing capability for a user (12 fig.1) to compose a message and record media associated with the message to send to another user over

the network via the networking mechanism (i.e., sending the email address of the callee through the connection server see fig.1, abstract, col.col.5 line 11 to col.6 line 36, col.6 line 60 to col.7 line 36 and col.9 lines 5-64).

As to claim 8, Mattaway discloses an operating system on which the email messaging program runs (see col.8 line 8 to col.9 line 64).

As to claim 10, Mattaway discloses capability uploads the media to a streaming media server communicatively coupled to the network over the network via the networking mechanism upon the message being sent to the other user over the network via the networking mechanism (processing audio and video data streams over the network, see col.14 lines 7-65 and col.16 line 12 to col.17 line 59).

As to claims 12 and 13, Mattaway discloses a playback capability for the user to view messages received from other users over the network via the networking mechanism and play back received media associated with the messages received and downloading the media associated with one of the messages received from the streaming media server over the network via the networking mechanism upon the user viewing the one of the messages received (i.e., establishing real time point to point of multimedia signals over the internet, see col.9 line 5 to col.10 line 56, col.16 line 12 to col.17 line 59 and col.29 line 30 to col.30 line 64).

As to claim 15, Mattaway at least one of: an analog modem, an Integrated Services Digital Network (ISDN) adapter, a network adapter card, a network adapter chipset, a cable modem, a Digital Subscriber Loop (DSL) modem, a digital modem, and a wireless modem (see col.4 lines 19-65 and col.5 lines 26-60).

Claims 16 and 17 are rejected for the same reasons set forth in claims 6 and 7 respectively.

As to claim 18, Mattaway discloses a method comprising:

saving a message entered by a user by an email messaging program(sending the email address of the callee through the connection server, see abstract, col.4 lines 14-65 and col.6 line 60 to col.7 line 53).

recording media associated with the message by the email messaging program, uploading the media to a streaming media server (26 fig.1) over a network by the email messaging program and sending the message over the network by the email messaging program (see col.6 lines 1-59, col.8 line 8 to col.9 line 64 and col.16 lines 12-56).

As to claim 19, Mattaway discloses receiving a second message over the network by the email messaging program; in response to a user requesting the email messaging program to display the second message, displaying the second message by the email messaging program, downloading second media associated with the message from the streaming media server over the network by the email messaging program and playing back the second media by the email messaging program (see col.8 line 8 to col.9 line 64, col.16 lines 12-56 and col.29 line 30 to col.30 line 64).

As to claim 22, Mattaway discloses a computer-readable medium having instructions stored thereon for an email messaging program comprising:

means for composing a first message by a first user and for recording first media associated with the first message to send to a second user over a network (sending the email address of the callee through the connection server, see abstract, col.4 lines 14-65 and col.6 line 60 to col.7 line 53).

means for viewing a second message received from the second user over the network by the first user, and for playing back second media associated with the second message (see col.6 lines 1-59, col.8 line 8 to col.9 line 64 and col.16 lines 12-56).

As to claim 23, Mattaway discloses uploading the first media to a streaming media server communicatively coupled to the network over the network upon the first message being sent to the second user over the network, and the means for viewing and for playing back downloads the second media from the streaming media server over the network upon the first user viewing the second message (see col.8 line 8 to col.9 line 64, col.16 lines 12-56 and col.29 line 30 to col.30 line 64).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 3, 11, 14, 20, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattaway et al., US pat. No.6,131,121 in view of Eyal US pat. No.6,389,467.

As to claims 3, 11, 14, Mattaway's teachings still applied as in item 3 above. Mattaway does not specifically disclose sending the media as an attachment to the message. However, Eyal discloses an email messaging program attaches the media as an attachment to the message upon the message being sent to the receiving user over the network, and the second email messaging program receives the media as the attachment to the message over the network (attaching in an email message the URL of the selected media resource, see abstract, fig.12, col.37 lines 4-61). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Eyal's teachings in to the computer system of Mattaway to help playing back media resources because it would have enabled users to access and automatically play back the media network resources of each of the signaled address over the network.

Claim 20 is rejected for the same reasons set forth in claim 18. As to the added limitation, Mattaway does not specifically disclose sending the media as an attachment to the message. However, Eyal discloses an email messaging program attaches the media as an attachment to the

message upon the message being sent to the receiving user over the network, and the second email messaging program receives the media as the attachment to the message over the network (attaching in an email message the URL of the selected media resource, see abstract, fig.12, col.37 lines 4-61). It would have been obvious to one of the ordinary skill in the art at the time the invention was made to implement Eyal's teachings in to the computer system of Mattaway to help playing back media resources because it would have enabled users to access and automatically play back the media network resources of each of the signaled address over the network.

As to claim 21, Mattaway discloses receiving a second message over the network by the email messaging program; in response to a user requesting the email messaging program to display the second message, displaying the second message by the email messaging program, downloading second media associated with the message from the streaming media server over the network by the email messaging program and playing back the second media by the email messaging program (see col.8 line 8 to col.9 line 64, col.16 lines 12-56 and col.29 line 30 to col.30 line 64).

Claim 24 is rejected for the same reasons set forth in claim 20.

Other prior art cited

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

   a. Mattaway et al. US apt. no.6,185,184.

b. Schneider, US pat. No.6,442,549.

c. Eyal, US pat. No.6,484,199.

d. Picard et al., US pat. No.6,223,318.

Conclusion

2. Claims 1-24 are rejected.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is 703-308-8528. The examiner can normally be reached on 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-5510 for regular communications and 703-746-7239 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

Khanh Dinh
Examiner
Art Unit 2155

***

May 16, 2003

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100